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09/922,823	08/06/2001	Derek Priestley	9052-74	8860

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EXAMINER

LEWIS, RALPH A

ART UNIT PAPER NUMBER

3732

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/922,823
Filing Date: August 06, 2001
Appellant(s): PRIESTLEY ET AL.

MAILED

AUG 23 2006

Group 3700

James R. Canon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02 June 2006 appealing from the Office action mailed 06 September 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 12-17, 43 and 57 are allowed and

Claims 1-11, 20-28, 30-32, 34-37, 39-41, 44, 46-51, 53 and 54 are rejected.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 07 November 2005 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 22, 23, 26-28, 30, 31, 34, 37, 39, 40, 44, 50, 51 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Morris et al (US 6,328,567).

Morris et al disclose a system comprising a digital camera (column 6, lines 55-68) for taking colored images, means for relaying the images (column 8, lines 24-31), means for analyzing the color values of the images (column 8, line 65 - column 10, line 56) and means for converting the color values into parameters from which the original color may be reconstituted (column 10, lines 57 – 67).

In regard to the “a single grey reference colour indicator” limitation, Morris et al discloses the use of a single “A1” dental shade tab 109 (column 8, line 59) which is described as “porcelain shade” (column 11, lines 34-45) or “a light tan color” (column 12, lines 62-63). First with respect to the “single” limitation, it is noted that applicant uses the open term “comprising” in the claims which indicates that the system may include elements other than those listed (See MPEP 2111.03). Consequently, the Morris et al system is interpreted as having a single gray color A1 indicator, a single black indicator and single white indicators.

In regard to the “grey” limitation, applicant’s specification provides little guidance on – i.e. why the color was chosen as opposed to a brown, tan or cream color or even if “grey” is distinct from the tans, cream and porcelain colors artificial teeth that contain a certain amount of gray color. With little guidance from applicant’s specification, the porcelain and tan colors of Morris et al are deemed to meet the “grey” limitation because porcelain and tan inherently include gray coloring. Applicant argues that tan

and grey are two separate and distinct colors. The examiner is of the position that there are shades of gray and/or tan that reasonable people would be split between calling the shade gray or calling the shade tan. Additionally, applicant provides a definition of gray as "relating to an achromatic color of any lightness between the extremes of white and dark" the examiner is of the position that porcelain shades similar to that of teeth as described by Morris et al meet this limitation. Moreover, the examiner is of the position a tan color is simply gray with a little bit of yellow and/or red added to it.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 20-24, 26-28, 30, 31, 34-37, 39, 40, 41, 44, 46-51, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al (US 6,328,567).

In regard to the "grey" limitation, to the extent that the light tan color of Morris et al fails to meet the limitation, it is noted that applicant has provided no criticality in the selection of the grey color as opposed to a tan, cream or ivory for instance. Morris et al suggest that the third color may be any color somewhere between black and white (column 7, lines 45-56), to have selected gray, a color intermediate between black and white, would have been obvious to one of ordinary skill in the art. Additionally, setting

the camera at a given focal length, encrypting data sent via the internet and the use of the Morris et al system to accurately determine the color of objects other than teeth would have been obvious to one of ordinary skill in the art as a matter of routine design and practice.

In regard to the present rejection applicant argues that his system uses only a single color reference whereas the Morris et al system uses three reference colors. It is noted that applicant's arguments are narrower than the claims. The claims use the open term "comprising" which indicates that other elements may be present in the claimed invention including other reference colors.

Claims 4, 25 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al (US 6,328,567) in view of Shahid et al (US 5,967,775).

Shahid et al teach that when trying to determine the color of a patient's teeth that it is desirable to provide for a polarized filter in order to improve the image sensed. To have provided the Morris et al image sensor with a polarized filter in order to improve the image as taught by Shahid et al would have been obvious to one of ordinary skill in the art.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al (US 6,328,567) in view of Lehmann et al (US 6,206,691).

Morris et al fail to set forth much detail regarding the camera used for acquiring the dental images, however, Lehmann et al for a similar dental color analyzer discloses

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a digital camera having a housing, point light sources 28 and having fiber optics (note Figure 13). To have used a camera having such features as those taught by Lehmann et al would have been obvious to one of ordinary skill in the art in light of the Lehmann teaching of such a camera being appropriate for such a use.

(10) Response to Argument

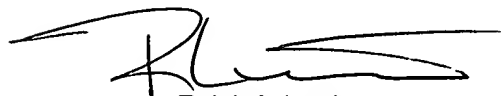
Applicant's arguments have been addressed in the section above explaining the rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

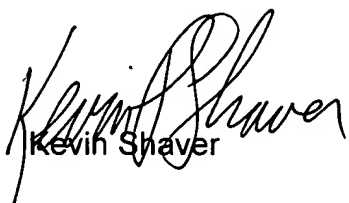
Respectfully submitted,



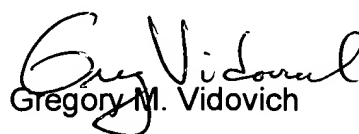
Ralph A. Lewis
Primary Examiner

Ralph Lewis

Conferees:



Kevin Shaver



Gregory M. Vidovich